

REMARKS

Claims 75-91 are pending in this application. Claims 1-74 have been canceled without prejudice or disclaimer to the subject matter therein. Claims 75-88 have been amended. Claims 89 and 90 have been withdrawn as directed to non-elected subject matter. Claim 91 has been newly added.

Claims 1-74 have been canceled without prejudice or disclaimer, and claims 75-88 have been amended, for the sole reason of advancing prosecution. Applicants, by canceling or amending any claims herein, make no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicants reserve the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application.

Claim 75 has been amended to recite "A method for controlling the processing of components involved in *in vitro* fertilization (IVF), comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning the two or more components with a unique machine readable identification mark; providing the unique machine readable identification mark assigned to the two or more components on a surface of the two or more components; generating photographic images of each of the unique machine readable identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more components simultaneously; generating data indicative thereof; and analyzing the data to determine whether the unique machine readable identification mark on each of the two or

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more components belong to the matching set.” Support for amended claim 75 can be found throughout the specification and claims as originally filed.

Claims 76-88 depend, either directly or indirectly, from claim 28. Claims 76-88 and have been amended to be in a form consistent with U.S. practice. For example, the term “said” has been deleted and replaced with the term “the.” Additionally, antecedent basis has been corrected. Claim 84 has been further amended to correct dependency. Amended claim 84 now depends from claim 76 rather than claim 75.

Newly added claim 91 is directed to a “method for controlling the processing of components involved in *in vitro* fertilization (IVF), comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning the two or more components with a unique machine readable identification mark; providing the unique machine readable identification mark assigned to the two or more components on a surface of the two or more components; generating photographic images of each of the unique machine readable identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more; generating data indicative thereof; and analyzing the data to determine whether the unique machine readable identification mark on each of the two or more components belong to the matching set.” Support for new claim 91 can be found throughout the specification and claims as originally filed.

No new matter has been added.

In view of the remarks set forth below, further and favorable consideration is respectfully requested.

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- I. At page 2 of the Official Action, claims 75-88 have been rejected under 35 USC § 103(a) as being unpatentable over Gianaroli et al. (Clinical Chemistry, Vol. 15 No. 10, pp. 2241-2246, 2000) in view of Whisler et al. (Clinical Chemistry, Vol. 36, No. 9, pp. 1587-1588, 1990).***

The Examiner asserts that it would have been obvious to modify procedures of processing IVF components of Gianaroli et al. with the use of barcodes in medical specimen processing of Whisler et al.

In view of the following, this rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, the Examiner must satisfy three requirements. First, as the U.S. Supreme Court very recently held in *KSR International Co. v. Teleflex Inc. et al.*, Slip Opinion No. 04-1350, 550 U. S. ____ (April 30, 2007), "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." (*KSR, supra*, slip opinion at 13-15.) Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was

made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

It is submitted that a *prima facie* case of obviousness has not been established because nothing in any of the applied references, whether taken alone or in combination, teach or suggest all of the limitations of the claims as required by *In re Wilson*.

Claim 75 is directed to method for controlling the processing of components involved in *in vitro* fertilization (IVF), comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning the two or more components with a unique machine readable identification mark; providing the unique machine readable identification mark assigned to the two or more components on a surface of the two or more components; **generating photographic images** of each of the unique machine readable identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more components **simultaneously**; generating data indicative thereof; and analyzing the data to determine whether the unique machine readable identification mark on each of the two or more components belong to the matching set. (Emphasis Added). Claims 76-88 depend, either directly or indirectly, from claim 75.

In contrast to the presently pending subject matter, Gianaroli et al. merely describe the methodology presented by the European Society for Human Reproduction Embryology (ESHRE) for good practices in IVF laboratories. However, Gianaroli et al. do not teach or suggest **generating photographic images** of each of the unique machine readable

identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more components ***simultaneously***, as presently claimed. Therefore, Applicants respectfully submit that Gianaroli et al. do not teach or suggest every element of the presently pending subject matter.

Whisler et al. do not remedy the deficiencies of Gianaroli et al. Whisler et al. is directed to an automated system for specimen identification and handling. Whisler et al. utilize barcodes to automate specimen identification and handling. See Whisler et al. at page 1587, column 1. However, like Gianaroli et al., Whisler et al. do not teach or suggest ***generating photographic images*** of each of the unique machine readable identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more components ***simultaneously***, as presently claimed. Therefore, whether taken alone or in combination, the cited references do not teach or suggest every element of the presently claimed subject.

In view of the remarks set forth herein, it is submitted that nothing in any of the applied references, taken alone or together, renders claims 75-88 obvious within the meaning of 35 USC § 103 (a). Accordingly, the Examiner is respectfully requested to withdraw this rejection.

II. New Claim 91

As discussed, new claim 91 is directed to a "method for controlling the processing of components involved in *in vitro* fertilization (IVF), comprising: defining a matching set of two or more components to be involved in a common IVF process; assigning the two or more components with a unique machine readable identification mark; providing the unique

machine readable identification mark assigned to the two or more components on a surface of the two or more components; generating photographic images of each of the unique machine readable identification marks assigned to the two or more components; reading the unique machine readable identification mark on each of the two or more; generating data indicative thereof; and analyzing the data to determine whether the unique machine readable identification mark on each of the two or more components belong to the matching set.”

Applicants respectfully submit that new claim 91 is also novel and non-obvious over the presently cited art because, whether taken alone, or in combination, Gianaroli et al. and Whisler et al. do not teach or suggest do ***generating photographic images*** of each of the unique machine readable identification marks assigned to the two or more components, as recited in claim 91. Accordingly, Applicants respectfully submit that claim 91 is novel and non-obvious.

CONCLUSION

Applicants assert that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

THE NATH LAW GROUP

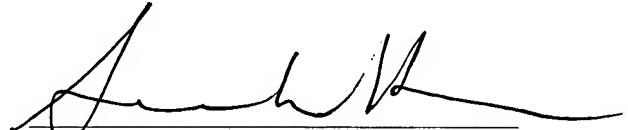
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